

Amendments to the Drawings

The attached sheet of drawings includes changes to Fig. 1. This sheet, which includes Fig. 1, replaces the original sheet including that same Figure.

DESCRIPTION OF CHANGE: The legend "CONVENTIONAL ART" is added to Fig. 1

Attachment: Replacement Sheet (1)

REMARKS

Applicant thanks the Examiner for the very thorough consideration given the present application.

Claims 1-13 are now present in this application. Claims 1, 7, 12 and 13 are independent.

Amendments have been made to the drawings, claims 12 and 13 have been added, and claims 1 and 7 have been amended. No new matter is involved. Basis for the amendments to claims 1 and 7, which recite detecting a level of a wobble extraction signal while a focusing servo is turned on but before a focusing servo adjustment has been completed, is found, for example, in Fig. 3, and in the description in the specification of steps S11-S34 of Fig. 3.

Reconsideration of this application, as amended, is respectfully requested.

Priority Under 35 U.S.C. § 119

Applicant thanks the Examiner for acknowledging Applicant's claim for foreign priority under 35 U.S.C. § 119, and receipt of the certified priority document.

Objection to the Drawings

The Examiner has objected to the drawings, stating that Fig. 1 should be designated by a legend such as "Prior Art" because only that which is old is illustrated in that figure.

In order to overcome this objection, Applicant respectfully submits that the suggestion in MPEP § 608.02(g) of the use of the phrase --Prior Art-- does not exclude the use of alternate

phrases, for example, "Background Art" and "Conventional Art". These alternative phrases may be found in many U.S. Patents issued today. The intent of MPEP § 608.02(g) is to distinguish Applicant's invention from that which is not Applicant's invention. If a drawing figure illustrates only material which is known to be statutory prior art to the invention, then the use of the phrase --Prior Art-- in the drawing figure would be proper. However, if it is not clear whether such material is statutory prior art, then the use of the phrase --Prior Art-- in the drawing figures would not be proper, and a label such as "Background Art" or "Conventional Art" would be more appropriate.

Applicant submits that the proposed drawing corrections filed herewith which include the label "Conventional Art" meet the criteria of MPEP § 608.02(g) and are sufficient to distinguish Applicant's invention from that which is not Applicant's invention. Accordingly, reconsideration and withdrawal of this objection, and approval of the proposed drawing corrections filed herewith, are respectfully requested.

Applicant also notes that the specification describes Fig. 1 as conventional art, so the proposed amendment to the drawings is consistent with that terminology in the specification.

Accordingly, reconsideration and withdrawal of this objection to the drawings are respectfully requested.

Rejection Under 35 U.S.C. § 112, 1st Paragraph

Claims 2, 3 and 8 stand rejected under 35 U.S.C. § 112, 1st Paragraph. This rejection is respectfully traversed.

The Examiner states that the features of claims 2 and 8 do not exist in the disclosure as originally filed, and that there is no detailed written description for the feature recited in Fig. 3.

Applicant respectfully disagrees for the following reasons.

Claims 2, 3 and 8 are original claims in this Application and, as such, are part of Applicant's original disclosure in this Application. It is well settled that the claims as filed are part of the specification, and may provide or contribute to compliance with Section 112. See Northern Telecom, Inc. v. Datapoint Corp., 908 F.2d 931, 938, 15 USPQ2d 1321, 1326 (Fed. Cir. 1990) (the original claims are part of the patent specification); In re Benno, 768 F.2d 1340, 1346, 226 USPQ 683, 686-87 (Fed. Cir. 1985); In re Frey, 166 F.2d 572, 575, 77 USPQ 116, 119 (CCPA 1948), cited in Hyatt v. Boone, 47 USPQ2d 1128, 1130 (Fed. Cir. 1998).

Moreover, claims 2 and 8 are completely consistent with the rest of Applicant's originally filed disclosure, which included the main body of the specification, the claims portion of the specification, and the drawings. For example, the paragraph bridging pages 8 and 9 of the main body of Applicant's specification clearly states that if the optical disk 10 is determined to be a CD-RW or CD-R, the microcomputer 70 performs two operations in sequence, the first being an optimal tracking gain adjustment according to the determined type of the optical disk 10 and the second causing the tracking servo to be turned on (S31). This is completely consistent with the statement in claims 2 and 8 that the level detection means detects the level of the wobble extraction signal while the tracking servo is off.

With respect to claim 3, which recites that the detected level of the wobble extraction signal for a disk for recording is higher than that of a disk for reproducing, support for this

feature is found not only in originally filed claim 3, itself, but also in the paragraph bridging pages 9 and 10, which points out that the level of the ATFM signal, which is a wobble extraction signal, of a CD-R is higher than that of a CD-ROM.

Moreover, to fully comply with the Rules of Practice, Applicant has added the subject matter of claims 2 and 8 to the main body of the specification.

Applicant respectfully submits that claims 2, 3 and 8, as amended, are fully supported by and adequately described in the written description of the invention.

Accordingly, reconsideration and withdrawal of this rejection are respectfully requested.

Rejection Under 35 U.S.C. § 102

Claims 1 and 7 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. patent Application Publication 2004/0218497 to Choi et al. ("Choi"). This rejection is respectfully traversed.

A complete discussion of the Examiner's rejection is set forth in the Office Action, and is not being repeated here.

A prior art reference anticipates the subject matter of a claim when that reference discloses every feature of the claimed invention, either explicitly or inherently. In re Schreiber, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997) and Hazani v. Int'l Trade Comm'n, 126 F.3d 1473, 1477, 44 USPQ2d 1358, 1361 (Fed Cir. 1997). While, of course, it is possible that it is inherent in the operation of the prior art device that a particular element operates as theorized by the Examiner, inherency may not be established by probabilities or possibilities. What is inherent, must

necessarily be disclosed. In re Oelrich, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981) and In re Rijckaert, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993).

During patent examination the PTO bears the initial burden of presenting a *prima facie* case of unpatentability. In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984).

If the PTO fails to meet this burden, then the applicant is entitled to the patent. However, when a *prima facie* case is made, the burden shifts to the applicant to come forward with evidence and/or argument supporting patentability. Patentability *vel non* is then determined on the entirety of the record, by a preponderance of evidence and weight of argument, *Id.*

Moreover, as stated in MPEP §707.07(d), where a claim is refused for any reason relating to the merits thereof it should be "rejected" and the ground of rejection fully and clearly stated.

Additionally, findings of fact and conclusions of law by the USPTO must be made in accordance with the Administrative Procedure Act, 5 U.S.C. §706(A), (E) (1994). Zurko v. Dickinson, 527 U.S. 150, 158, 119 S.Ct. 1816, 1821, 50 USPQ2d 1930, 1934 (1999).

A claim limitation is inherent in the prior art if it is necessarily present in the prior art, not merely probably or possibly present. Rosco v. Mirro Lite, 304 F.3d 1373, 1380, 64 USPQ2d 1676 (Fed. Cir. 2002). The dispositive question regarding anticipation is whether one skilled in the art would reasonably understand or infer from the prior reference's teaching that every claim feature or limitation was disclosed in that single reference, Dayco Products, Inc. v. Total Containment, Inc., 329 F.3d 1358, 1368, 66 USPQ2d 1801 (Fed. Cir. 2003).

Claims 1 and 7, as amended, recite a combination of features that is not disclosed by Choi. As amended, claim 1, recites detecting a level of a wobble extraction signal while a focusing servo is turned on but before a focusing servo adjustment has been completed. Choi does not disclose this feature. Choi clearly discloses, in paragraph [0011], that it does just the opposite, i.e., it discriminates between a plurality of types of disks using an amplitude of a wobble signal detected *during the controlling of the focus*. Choi also discloses, in Fig. 4, that it controls the optical disc in an on-focus state, in step 402, before it measures the amplitude of the wobble signal to determine the type of the disc.

Accordingly, the Office Action fails to make out a *prima facie* case of anticipation of the claimed invention by Choi.

Rejections under 35 U.S.C. § 103

Claims 1 and 7 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application publication 2004/0130991 to Tawaragi. This rejection is respectfully traversed.

A complete discussion of the Examiner's rejection is set forth in the Office Action, and is not being repeated here.

Because the rejection is based on 35 U.S.C. § 103, what is in issue in such a rejection is "the invention as a whole, "not just a few features of the claimed invention. Under 35 U.S.C. §103, " [a] patent may not be obtained . . . if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said

subject matter pertains." The determination under §103 is whether the claimed invention as a whole would have been obvious to a person of ordinary skill in the art at the time the invention was made. See In re O' Farrell, 853 F.2d 894, 902, 7 USPQ2d 1673, 1680 (Fed. Cir. 1988). In determining obviousness, the invention must be considered as a whole and the claims must be considered in their entirety. See Medtronic, Inc. v. Cardiac Pacemakers, Inc., 721 F.2d 1563, 1567, 220 USPQ 97, 101 (Fed. Cir. 1983).

In rejecting claims under 35 U.S.C. § 103, it is incumbent on the Examiner to establish a factual basis to support the legal conclusion of obviousness. See, In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the Examiner is expected to make the factual determinations set forth in Graham v John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one of ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal Inc. v. F-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hospital Systems, Inc. v Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the Examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note, In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). The mere fact that the prior art may be modified in the manner suggested

by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783 84 (Fed. Cir. 1992). To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be suggested or taught by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1970). All words in a claim must be considered in judging the patentability of that claim against the prior art. In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

A suggestion, teaching, or motivation to combine the prior art references is an "essential evidentiary component of an obviousness holding." C.R. Bard, Inc. v. M3 Sys. Inc., 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998). This showing must be clear and particular, and broad conclusory statements about the teaching of multiple references, standing alone, are not "evidence." See In re Dembiczak, 175 F.3d 994 at 1000, 50 USPQ2d 1614 at 1617 (Fed. Cir. 1999).

Moreover, it is well settled that the Office must provide objective evidence of the basis used in a prior art rejection. A factual inquiry whether to modify a reference must be based on objective evidence of record, not merely conclusory statements of the Examiner. See, In re Lee, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002).

Furthermore, during patent examination, the PTO bears the initial burden of presenting a *prima facie* case of unpatentability. In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785788 (Fed. Cir. 1984). If the PTO fails to meet this burden, then the Applicant is entitled to the patent. Only when a *prima*

facie case is made, the burden shifts to the applicant to come forward to rebut such a case.

Claims 1 and 7, as amended, recite a combination of features that is not disclosed by Tawaragi. As amended, claim 1, recites detecting a level of a wobble extraction signal while a focusing servo is turned on but before a focusing servo adjustment has been completed. Tarawagi does not disclose this feature. Tarawagi clearly discloses, in paragraphs [0029 and [0032], that it does just the opposite, because its wobble detection is of a focus error control signal, i.e., it uses an amplitude of a wobble signal detected during the controlling of the focus.

Accordingly, the Office Action fails to make out a *prima facie* case of obviousness of the invention recited in claims 1 and 7.

Reconsideration and withdrawal of this rejection of claims 1 and 7 are respectfully requested.

Claims 1-11 stand rejected under 35 USC § 103(a) as being unpatentable over U.S. Patent 6,859,425 to Maegawa. This rejection is respectfully traversed.

Applicant respectfully submits that Maegawa does not even disclose discrimination between different types of optical disks based on detecting a wobble signal. Maegawa does not explicitly disclose doing so and, although Maegawa discloses that its invention can be used for plural types of recording media, Maegawa's invention is directed to detect a wobble signal having high accuracy and stability when used to record information onto optical disks

Applicant cannot find any disclosure in Maegawa concerning how it goes about determining the type of disk that uses the wobble signals to improve recording of information

onto an optical disk.

The Office Action fails to refer to specific disclosure in Maegawa of the claimed invention. Nor does the Office Action provide objective factual evidence of any inherent disclosure of the claimed invention by Maegawa. It should be remembered, as pointed out in the case law cited above, that for something to be inherently disclosed, it cannot be just possibly disclosed, and cannot just be probably disclosed. It must necessarily be disclosed. However, Maegawa fails to contain such disclosure of Applicant's claimed invention.

The Office Action refers to col. 3, lines 10-44 to support its conclusion that Maegawa is capable of discrimination between CD-ROM, DVD-ROM, CD-R/w or DVD-R/RW. However, Maegawa never mentions these different types of disks in col 3.

Moreover, Maegawa's wobble detection circuit 30 detects the wobble signal based on signal Sc and signal Sd (col. 12, lines 47-48), and those signals are generated using the tracking error signal and the focus error signal, as disclosed in col. 12, lines 35-63. Thus Maegawa teaches away from disclosing or suggesting the claimed invention.

With respect to claim 3, what is recited is not use of a higher wobble signal level, although this is what is addressed in the rejection of claim 3. What is claimed is where the detected level of the wobble extraction signal for a disk for recording is higher than that of a disk for reproducing. Maegawa has no disclosure of this feature because it is directed only to disks that are recordable.

Accordingly, the Office Action fails to make out a *prima facie* case of obviousness of the invention recited in claims 1-11.

Reconsideration and withdrawal of this rejection of claims 1-11 are respectfully requested.

Claims 12 and 13

Claims 12 and 13 are added. Support for claims 12 and 13 is found throughout Applicant's originally filed disclosure, including Fig. 3, and the originally filed claims, and the main body of the specification.

Applicant respectfully submits that the combinations of features in claims 12 and 13 are neither disclosed nor suggested by any of the applied references.

Consideration and allowance of claims 12 and 13 are respectfully requested.

Additional Cited References

Because the remaining references cited by the Examiner have not been utilized to reject the claims, but have merely been cited to show the state of the art, no comment need be made with respect thereto.

Conclusion

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. It is believed that a full and complete response

has been made to the outstanding Office Action, and as such, the present application is in condition for allowance.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone Robert J. Webster, Registration No. 46, 472, at (703) 205-8000, in the Washington, D.C. area.

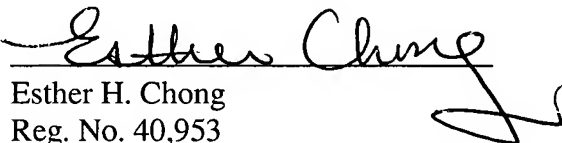
Prompt and favorable consideration of this Amendment is respectfully requested.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Date: July 17, 2007

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By: 
Esther H. Chong
Reg. No. 40,953

JTE/RJW:mmi:tm

P.O. Box 747
Falls Church, Virginia 22040-0747
Telephone: (703)205-8000

Attachment: Replacement Drawing Sheet (1) – Figure 1